

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHIANG ALEXANDER and JOE D. BOLDING

Appeal 2007-1981
Application 09/986,221¹
Technology Center 2100

Decided: November 28, 2007

Before ANITA PELLMAN GROSS, MAHSHID D. SAADAT,
and MARC S. HOFF, *Administrative Patent Judges*.

HOFF, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 from a Final Rejection of claims 1-6, 9-13, and 15-19. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

Appellants' invention relates to providing a system that indexes text according to an arbitrary set of indices and automatically generates hyperlinks from each index to a related topic in a document. Document

¹ Application filed October 22, 2001. The real party in interest is Hewlett-Packard Development Company, L.P.

linking and updating is automated. Documentation is automatically available over the Internet, since the invention automatically copies all of the necessary files to the appropriate web server (Spec. 2).

Claim 1 is exemplary:

A system for linking a plurality of indices with related subjects and target text associated with each of the subjects comprising the steps of:

generating a global index file comprising said subjects and a corresponding address of the text associated therewith;

generating a data structure indicative of a correspondence between said indices and associated said subjects;

generating a subject name file comprising HTML-encoded target text associated therewith, for each of the subjects;

generating, for each of the indices, a first set of hyperlinks wherein each of the hyperlinks therein links one of the indices to the target text corresponding to one of the subjects in one of the indices;

generating a second set of hyperlinks wherein each of the hyperlinks therein links one of the subjects to the text corresponding thereto in the subject name file;

copying the first set of hyperlinks, the second set of hyperlinks, and the HTML-encoded target text to a web site; and

updating, on a web site, the hyperlinks necessary to link a web page on the web site to a new version of the document containing the HTML-encoded target text.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Sotomayor	US 5,708,825	January 13, 1998
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Claims 1-6, 9-13, and 15-19 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Sotomayor.

Appellants contend that the Examiner erred in his rejections because Sotomayor does not teach (a) copying hyperlinks and encoded text to a web site or (b) updating, on a web site, the hyperlinks necessary to link a web page on the web site to a new version of a document (Br. 7-8). The Examiner contends that the claims are properly rejected because Sotomayor generates HTML files that reside on a computer, which the Examiner characterizes as meeting the definition of a “web site” (Ans. 10).

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Briefs and the Answer for their respective details. Only those arguments actually made by Appellants have been considered in this decision. Arguments that Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ISSUE

The principal issue in the appeal before us is whether the Examiner erred in holding that Sotomayor teaches copying hyperlinks and text to a web site and automatically updating, on a web site, the hyperlinks necessary to link to a new version of a document.

FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

The Invention

1. Appellants invented a system that indexes text according to an arbitrary (i.e., not necessarily alphabetical) set of indices and automatically generates hyperlinks from each index to a related topic in a document (Spec. [0009]).
2. Appellants describe a need for “a system that automatically updates the hyperlinks [automatically] generated [from indexed text] to Internet-accessible web pages” (Spec. [0008]).
3. One advantage of Appellants’ invention is that “the documentation is instantly available over the Internet, since the present invention automatically copies all of the necessary files to the appropriate web server” (Spec. [0009]).
4. A hyperlink processing program creates a category file that indicates an association between each topic of interest in a document and corresponding subjects included in each topic; generates a data structure that associates each topic and corresponding subject names in accordance with the association defined in the category file; generates a plurality of subject name files; generates a global index file comprising hyperlinks to each subject name file; and generates a plurality of index files, each including hyperlinks between each of the topics and corresponding subject name files (Spec. [0010-0011]).

5. The hyperlink processing program displays a list of category names in a first window, using hyperlinks in the index files; then displays a list of subject names in a second window, in response to a user selecting one of the category names; then, in a third window, displays the text in the subject name file corresponding to the subject name selected by the user, using hyperlinks in the global index file (Spec. [0010-0011]).

Sotomayor

6. Sotomayor teaches a system that scans one or more documents, automatically identifies significant key topics, concepts, and phrases in the documents, and creates summary pages for, and hyperlinks between, these key topics (col. 4, ll. 11-15).

7. In response to an author's selection of documents, the system automatically identifies key topics, compiles those topics into summary pages, generates presentation pages by segmenting the selected documents into smaller pieces, and embeds hyperlinks from the summary pages to the locations where key topics appear in the presentation pages (col. 4, ll. 21-31).

8. Summary pages are pages which are typically viewed using a web browser program and which contain lists of key topics and hyperlinks to places in the selected documents where the key topics appear. The summary page provides an index to the source document, and can be viewed by a document viewer program such as a word-processor program or a web-browser program (col. 4, ll. 34-48).

Dictionary definitions of "web site"

9. Dictionary.com Unabridged, based on the Random House Unabridged Dictionary, defines "web site" as "a connected group of pages on the World Wide Web regarded as a single entity."²

10. WordNet defines "web site" as "a computer connected to the internet that maintains a series of web pages on the World Wide Web."³

11. The Free On-Line Dictionary of Computing defines "web site" as "[a]ny computer on the Internet running a World-Wide Web server process."⁴

12. The American Heritage Science Dictionary defines "web site" as "A set of interconnected webpages, usually including a homepage, generally located on the same server, and prepared and maintained as a collection of information by a person, group, or organization."⁵

PRINCIPLES OF LAW

Anticipation is established when a single prior art reference discloses expressly or under the principles of inherency each and every limitation of the claimed invention. *Atlas Powder Co. v. IRECO Inc.*, 190 F.3d 1342,

² "website." *Dictionary.com Unabridged (v 1.1)*. Random House, Inc., 2006 available at <http://dictionary.reference.com/browse/website>.

³ "website." *WordNet® 3.0*. Princeton University, 2006, available at <http://dictionary.reference.com/browse/website>.

⁴ "website." Denis Howe, *The Free On-line Dictionary of Computing*, 1993-2007, available at <http://dictionary.reference.com/browse/website>.

⁵ "website." Houghton Mifflin Company, *The American Heritage® Science Dictionary*, available at <http://dictionary.reference.com/browse/website>.

1347 (Fed. Cir. 1999); *In re Paulsen*, 30 F.3d 1475, 1478-79 (Fed. Cir. 1994).

Our reviewing court states that “claims must be interpreted as broadly as their terms reasonably allow.” *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989). Our reviewing court further states that “the words of a claim ‘are generally given their ordinary and customary meaning.’” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc)(internal citations omitted). The “ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application.” *Id.* at 1313. The description in the specification can limit the apparent breadth of a claim in two instances: (1) where the specification reveals a special definition given to a claim term by the patentee that differs from the meaning it would otherwise possess; and (2), where the specification reveals an intentional disclaimer, or disavowal, of claim scope by the inventor. *Id.* at 1316.

ANALYSIS

Appellants argue that the Examiner erred in holding that Sotomayor teaches the claim limitations of “copying the first set of hyperlinks, the second set of hyperlinks, and the HTML-encoded target text to a web site,” and “updating, on a web site, the hyperlinks necessary to link a web page on the web site to a new version of the document containing the HTML-encoded target text” (Br. 9). Specifically, Appellants contend that Sotomayor does not perform copying *to a web site*, nor updating *on a web*

site, because Sotomayor fails to teach that the computer containing the sets of hyperlinks and the HTML-encoded target text is connected to the Internet (Br. 9-10). Without an internet connection, Appellants argue, Sotomayor does not teach a “web site” (*id.*).

The Examiner tacitly concedes that Sotomayor does not teach copying or updating to an Internet-connected web site (Ans. 10). The Examiner, however, defines a “web site” as “a set of related web pages that are served to a user” (*id.*), albeit without providing a source for that definition. It is the Examiner’s position that a web site server can be resident on a local, standalone computer (*id.*). Because the HTML documents generated by Sotomayor are stored on the user’s computer and viewable on a web browser, and because a user may obtain HTML documents from the Internet and generate summaries using Sotomayor’s invention, the Examiner determines that these summaries “constitute a web site, on a personal intranet consisting of a single user computer” (Ans. 11).

To determine the ordinary and customary meaning of the term “web site,” our reviewing court (see *Phillips, supra*) commands us to look first to the Specification. While no explicit definition of “web site” is provided, the Specification does provide clues to Appellants’ intent. The Background of the Invention describes a need for “a system that automatically updates the hyperlinks generated [automatically from indexed text] to Internet-accessible web pages” (FF 2). Next, Appellants express an advantage of their invention: “the documentation is instantly available over the Internet, since the present invention automatically copies all of the necessary files to the appropriate web server” (FF 3).

Dictionary.com Unabridged defines “web site” as “a connected group of pages on the World Wide Web regarded as a single entity” (FF 9). WordNet defines the term as “a computer connected to the internet that maintains a series of web pages on the World Wide Web” (FF 10). The Free On-Line Dictionary of Computing defines “web site” as “any computer on the Internet running a World-Wide Web server process” (FF 11). The American Heritage Science Dictionary defines “web site” as “A set of interconnected webpages, usually including a homepage, generally located on the same server, and prepared and maintained as a collection of information by a person, group, or organization” (FF 12). Although this last definition does not require connection to the Internet, thus coming closest to the Examiner’s position, it does still require the interconnected webpages to be located on the same server, and given that the standalone computer cited in the Examiner’s arguments lacks the capacity to serve files to other computers, it would not qualify as a “server,” and thus could not fulfill even that definition of “web site.” Taking these definitions together, then, we find that the person having ordinary skill in the art would have understood the claim term “web site” to mean a set of web pages on a computer which is connected to the Internet.

Because Appellants' Specification evidences an intent that the web pages generated are to be available over the Internet, and because we find *supra* that the ordinary and customary meaning of "web site" requires the computer where the web pages reside to be "on the Internet," we find that the term "web site" as used in Appellants' claims refers to a computer connected to the Internet. Because the computer of Sotomayor is not connected to the Internet, we find that Sotomayor does not teach the claim limitations of copying to a web site, nor updating hyperlinks on a web site. Sotomayor therefore does not teach all the limitations of claims 1, 9 or 16, and we find that the Examiner's rejection of those claims as being anticipated by Sotomayor is in error.⁶

As a result, we reverse the rejection of independent claims 1, 9, and 16, as well as claims 2-6, 10-13, 15, and 17-19, which are dependent therefrom and not separately argued.

CONCLUSION OF LAW

We conclude that the Examiner erred in rejecting claims 1-6, 9-13 and 15-19. On the record before us, claims 1-6, 9-13 and 15-19 have not been shown to be unpatentable.

DECISION

The Examiner's rejection of claims 1-6, 9-13, and 15-19 is reversed.

⁶ We do observe that the rejection before us is on the ground of anticipation under 35 U.S.C. § 102, rather than obviousness under 35 U.S.C. § 103. We have not considered any obviousness rejections over Sotomayor in combination with other prior art, as none are before us.

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REVERSED

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